

### **REMARKS**

This responds to the Office Action mailed on May 22, 2003. Claims 1, 3 – 5, 9, 17, and 26 are amended. Claims 34 and 35 are added. No claims are cancelled. As a result, claims 1 – 5, 9 – 13, and 17 – 33 are pending in this patent application.

#### **Restriction of Claims**

The Examiner withdrew claims 23 – 25, and 32 – 33 are being directed toward a non-elected invention. Applicant defers cancellation of such claims until all other claims are indicated to be allowable. Upon any such future cancellation, Applicant reserves the right to reintroduce such claims in one or more continuation or divisional patent applications.

#### **§112 Rejection of the Claims**

Claims 17-22 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicant has amended claim 17 to correct the antecedent basis referred to in the rejection. Because such corrections to antecedent basis merely clarify subject matter already recited in the claim, such corrections are believed to be non-narrowing. Accordingly, Applicant respectfully requests withdrawal of this basis of rejection of claim 17 and its dependent claims 18 – 22, which incorporate all of the language of claim 17.

#### **§102 Rejection of the Claims**

Claims 1, 9 and 17 were rejected under 35 U.S.C. 102(b) for anticipation by Stine et al. (U.S. Patent No.: 6,027,514). Applicant respectfully traverses.

Regarding claim 1, Applicant can find no disclosure in Stine et al. of a cutting edge that permits ultrasound or other acoustic vibration substantially independently from the introducer, as presently recited in claim 1.

Regarding claim 9, Applicant can find no disclosure in Stine et al. of using a cutting member that permits ultrasound or other acoustic vibration substantially independently from the introducer and cutting tissue entering the opening by moving the cutting member with respect to

the opening without rotating the cutting member and without using electric current for performing the cutting, as presently recited in claim 9.

Regarding claim 17, Applicant can find no disclosure in Stine et al. of a means for cutting that permits ultrasound or other acoustic vibration substantially independently from the introducer, as presently recited in claim 17.

Accordingly, Applicant respectfully requests withdrawal of these bases of rejection of these claims.

#### §103 Rejection of the Claims

Claims 1-5 and 9-13 were rejected under 35 U.S.C. § 103(a) for obviousness over Kresch et al. (U.S. Patent No. 5,527,331). Applicant respectfully traverses.

Regarding claims 1 – 5 and claims 9 – 13, these claims presently recite or incorporate cutting without using electric current for performing the cutting. Applicant can find no such disclosure, teaching, or suggestion in Kresch et al., which the Examiner has recognized instead uses electrosurgery. (See Office Action at 4.) Because no *prima facie* case of obviousness presently exists with respect to these claims, Applicant respectfully requests withdrawal of this basis of rejection.

#### Allowed Claims 26- 31

The Applicant notes with appreciation the allowance of claims 26- 31. However, because the word “biocompatible” is not needed for the patentability of the claims, claims 26 and 29 have been amended to remove the term “biocompatible.” Applicant believes that claims 26 – 31 remain allowable, and respectfully requests allowance of such claims.

#### New Claims

Applicant has added new dependent claims 34 – 35 to more particularly point out and distinctly claim aspects of the present subject matter. Applicant respectfully requests allowance of such claims.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 371-2109) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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9/22/2003

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of September, 2003.

PATRICIA A. HULTMAN  
Name

Signature